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SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1952

No. [redacted]86

TOPPS CHEWING GUM, INC.,
Petitioner

vs.

HAELAN LABORATORIES, INC.,
Respondent

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PETITION FOR WRIT OF CERTIORARI TO THE COURT OF APPEALS FOR THE SECOND CIRCUIT AND BRIEF IN SUPPORT THEREOF.

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Prosser, Handbook of the Law of Torts, Hornbook Series, 1941, page 1059 21

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Respondent

PETITION FOR WRIT OF CERTIORARI

To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

YOUR PETITIONER, Topps Chewing Gum, Inc., prays for a writ of certiorari to the United States Court of Appeals for the Second Circuit to review the judgment of that Court in this cause filed on March 20, 1953 (R. 774). A certified transcript of the record in this case including the proceedings in the Court of Appeals is being filed in accordance with the rules of this Court.

SUMMARY STATEMENT OF THE MATTER INVOLVED.

Certain professional baseball players gave respondent (previously known as Bowman Gum, Inc.) the exclusive permission, in writing, for a limited time, to use their names and pictures in connection with the advertising and sale of its chewing gun. The permission given by Larry Berra for the 1950 season is typical and reads in part (R. 518):

> "In consideration of $1.00 to me in hand paid, and further consideration recited herein, I hereby grant

permission to Bowman Gum, Inc. to exhibit, display, print and publish my name, and/or signature or facsimile thereof, and/or photograph and a descriptive and/or biographical sketch in the advertising, promotion and sale of its chewing gum products for the calendar year 1950, with the understanding that this permission again will be granted by me on the same terms for the year of 1951 if requested by Art Flynn Associates on behalf of Bowman Gum, Inc.

"It is part of this agreement that during said period of one year I will grant to no other manufacturer of chewing gum the above mentioned permission, rights, privileges or any of them; or the right to use my name, signature or picture in any manner; and that I will grant to no one the right to sell or distribute my name, picture or signature for reproduction or use in any manner by any other manufacturer of chewing gum." (R. 518)

Petitioner, having subsequently obtained permission from the same players to use their names and pictures in connection with the advertising and sale of its candy, did so use them during the period of respondent's exclusive rights. (The difference between chewing gum and candy may be disregarded in this petition.)

The parties have used the names and pictures of hundreds of major league players on picture cards wrapped with their gum or candy. The players do not endorse the products and their names and pictures have no trademark significance. The cards, sometimes known as trading cards, are collected by children and some adults.

This is a civil action brought by respondent charging petitioner with

1. Unlawfully using the names and pictures of professional baseball players on picture cards enclosed with

petitioner's candy in violation of the exclusive permission given respondent by the same players to use their names and pictures in connection with the sale of respondent's bubble gum (complaint, paragraph 19, R. 17), and

2. Impairing the value of respondent's rights under its contracts with those ball players by entering into agreements with them (complaint, paragraph 20, R. 18).

There is no charge of trade-mark or copyright infringement.

Petitioner filed a defensive counterclaim charging respondent with inducing certain players to breach contracts under which petitioner claimed exclusive rights (counterclaim, paragraph 35, R. 38).

The ball players are not parties.

The District Court's jurisdiction is based on diversity of citizenship, 28 U. S. C. 1332 (a) 1, and New York law governs.

The District Court (Eastern District of New York, Judge Galston) held that the right asserted in each instance was a mere waiver of the player's right of privacy, created in New York by Sections 50 and 51 of the Civil Rights Law, and properly considering himself bound by the construction of that statutory right by the courts of this state, held the right to be personal and non-assignable and not enforceable by either party against the other. He thereupon dismissed both complaint and counterclaim (Opinion, R. 722, 723 and Judgment, R. 731).

The New York case chiefly relied upon by Judge Galston was *Pekas Co. Inc.* v. *Leslie, et al.*, 50 N. Y. L. J. 1864, February 13, 1915, Supreme Court, Special Term, New York County, in which the facts were on all fours with the instant case, if professional actresses be substituted

for professional ball players. In dismissing the action in that case Justice Greenbaum had written:

> "The rights and remedies of the persons aggrieved are purely personal and not assignable. Rights for outraged feelings are no more assignable than would be a claim arising from a libelous utterance. The alleged agreements made between the actresses in question and the plaintiff, under which the plaintiff was given the exclusive right to publish the portraits, may have conferred rights which the plaintiff might have protected by copyright, but none in favor of the plaintiff against the defendants under the Civil Rights Law of Privacy. Judgment for the defendants, without costs."

The other case chiefly relied upon by Judge Galston was *Hanna Mfg. Co.* v. *Hillerich & Bradsby Co.*, 78 F. 2d 763, cert. denied, 296 U. S. 645, decided by the Circuit Court of Appeals for the Fifth Circuit. There the facts were also on all fours with those of the instant case, even to the involvement of professional baseball players. Two such players, Babe Ruth and Lou Gehrig, had given the plaintiff the exclusive permission to use their names on plaintiff's bats. The defendant used those names on its bats and was sued by the plaintiff. The District Court held for the plaintiff. The Court of Appeals for the Fifth Circuit, reversed, holding that the contracts between the players and the plaintiff "operate only to prevent the signers from objecting to appellee's use of their names and likenesses" and conferred no right on the plaintiff to sue for enforcement of that right.

A majority of the Court of Appeals for the Second Circuit (Judges Clark and Frank, with Chief Judge Swan dissenting) rejecting petitioner's "contention that none of plaintiff's contracts created more than a release of liability, because a man has no legal interest in the publi-

cation of his picture other than his right of privacy, *i. e.*, a personal and non-assignable right * * *", held that the right involved was *not* the personal, non-assignable, statutory right of privacy, but what Judge Frank was pleased to call a "right of publicity" which, so he said, is "in addition to and independent of that right of privacy" and may be transferred "in gross" (R. 760, 761):

> "This right might be called a 'right of publicity'. For it is common knowledge that many prominent persons (especially actors and ball players), far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways. This right of publicity would usually yield them no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures.
>
> "We think the New York decisions recognize such a right." (Here the Court of Appeals cited two New York cases and one old Federal case, none of which is in point.)

Plaintiff sued, said Judge Frank "in its capacity as exclusive grantee of a player's 'right of publicity'" (R. 762).

In finding the decision of the Supreme Court of New York in the *Pekas* case not controlling the Court of Appeals assigned two reasons: (1) "a doubt as to whether an opinion of that Court must be taken by us as an authoritative exposition of New York Law", and (2) "the opinion shows that the judge had his attention directed by plaintiff exclusively to Sections 50 and 51 of the New York statute". The Court was wrong on both counts.

As for *Hanna Mfg. Co.* v. *Hillerich & Bradsby Co.*, the decision of the Court of Appeals for the Fifth Circuit on which Judge Galston relied, the Court of Appeals for the Second Circuit dismissed it summarily: "We do not agree with *Hanna Mfg. Co.* v. *Hillerich & Bradsby Co.*, 78 F. 2d 763, C. A. Fifth".

So the Court of Appeals reversed Judge Galston and remanded the case for application of the new law.

JURISDICTION

Jurisdiction of this Court is invoked under Section 1254, Title 28, U. S. C.

The date of the judgment of the Court of Appeals which petitioner seeks to have reviewed is March 20, 1953, when an order was entered amplifying the Court's opinion on petitioner's timely petition for rehearing (R. 774). The time for applying for certiorari under Section 2101 (c), Title 28, U. S. C., runs from March 20, 1953, the date of the order on the petition for rehearing. *Labor Board* v. *Mackay Co.*, 304 U. S. 333, 343, 344.

THE QUESTIONS PRESENTED.

1. Is there at common law or by statute in New York such a thing as a "right of publicity", assignable in gross and enforceable by the assignee against a third party, a right "in addition to and independent of" the right of privacy?

2. Was the permission to use their names and pictures on cards sold with chewing gum, which the ball players gave to respondent, a grant of a "right of publicity", enforceable by the grantee, like a copyright, or was it a mere waiver of the players' limited right of privacy, a personal, non-assignable right created in New York by Sections 50 and 51 of the Civil Rights Law and enforceable only by the players?

3. May one who has been given permission by a professional baseball player to use his name and picture on picture cards sold with bubble gum in New York, coupled with an agreement by the player not to give the same permission to another, sue a third party who uses that player's name and likeness on picture cards sold with candy or bubble gum, or must the suit be brought by the baseball player?

4. Are the federal courts of New York bound to follow the local law as enunciated and interpreted by the Supreme Court of New York?

REASONS FOR GRANTING THE WRIT.

In deciding that the permission given respondent by professional baseball players to use their names and pictures on picture cards to be sold with respondent's bubble gum in New York constituted a grant or assignment of the players' "right of publicity", a right transferable in gross, like a copyright, and enforceable by the grantee, and not a mere waiver of the players' limited, personal and non-assignable right of privacy created by Sections 50 and 51 of the Civil Rights Law of the state, the United States Court of Appeals for the Second Circuit has

1. Attempted to legislate for the people of the State of New York whose duly elected representatives have created no such right.

2. Decided an important question of local law in conflict with the applicable decisions of the courts of New York which have consistently held that there is no means whereby a person may prevent the respectful use of his name or picture in this state except under the provisions of the right of privacy statute, which created a limited, personal, non-assignable right of privacy. The Court of Appeals has singled out actors and ball players as persons

particularly avid for publicity. The pre-eminence of New York in the entertainment and sports fields makes it especially important that the federal courts sitting in this state should follow the law of the state.

3. Rendered a decision in conflict with a decision of the Court of Appeals for the Fifth Circuit on the same point of law.

WHEREFORE YOUR PETITIONER respectfully prays that a writ of certiorari be issued to the United States Court of Appeals for the Second Circuit to the end that this cause may be reviewed and determined by this Court; that the judgment of the Court of Appeals for the Second Circuit be reversed and that of the District Court affirmed; and that petitioner be granted such other and further relief as may be proper.

TOPPS CHEWING GUM, INC.,
GEORGE E. MIDDLETON,
Counsel for Petitioner.

New York, N. Y.,
May 21, 1953.

BRIEF IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

OPINIONS OF THE COURTS BELOW.

The opinion of the District Court for the Eastern District of New York, written by Judge Galston, appears at page 704 of the Record and is reported in 103 F. Supp. 944. The opinion of the Court of Appeals for the Second Circuit (Judges Clark and Frank with Chief Justice Swan dissenting) written by Judge Frank, appears at page 758 of the Record and is reported in 202 F. 2d 866.

JURISDICTION.

The jurisdictional statement appears in the accompanying petition.

STATEMENT OF THE CASE.

The essential facts of the case are stated in the accompanying petition and need not be repeated here.

SPECIFICATION OF ERRORS.

The Court of Appeals for the Second Circuit erred:

1. In holding that the permission which the ball players gave respondent to use their names and pictures on cards sold with respondent's gum was a "right of publicity", assignable in gross like a copyright and enforceable by respondent as the players' exclusive grantee and not a mere waiver of the players' personal, non-assignable, statutory right of privacy, enforceable only by the players.

2. In holding that the decisions of the New York courts recognize a "right of publicity", a right "in addition to and independent of" the right of privacy.

3. In refusing to follow the law as enunciated by the Supreme Court of New York in *Pekas Co. Inc.* v. *Leslie, et al.*

4. In refusing to agree with the decision of the Court of Appeals for the Fifth Circuit in *Hanna Mfg. Co.* v. *Hillerich & Bradsby Co.*

5. In reversing the judgment of the District Court.

SUMMARY OF ARGUMENT.

A non-libelous publication of one's name and likeness is not tortious at common law in New York, and prior to the enactment in 1903 of the New York right of privacy statute, Sections 50 and 51 of the Civil Rights Law, creating a limited right of privacy, there was no redress in this state for the use of one's name or picture for purposes of advertising or trade. Any redress must, therefore be had, if had at all, under the statute, and the New York courts have consistently construed the right granted by the statute as personal and non-assignable.

The United States Court of Appeals for the Second Circuit has presumed to create in this state an assignable "right of publicity". No such right exists here at common law or under any New York statute. If this "right of publicity" differs from the right of privacy created fifty years ago by the New York Legislature in Sections 50 and 51 of the New York Civil Rights Law—and the Court of Appeals has so declared—then the judgment of the Court of Appeals is an unwarranted act of judicial legislation. If, on the other hand, this "right of publicity" turns out to be, on closer examination, the right to control—at a price—the publicity given one's name and picture for purposes of advertising and trade, then it is indistinguishable from the statutory right of privacy and must be subject to the limitations which the courts of this state have placed

upon that right, chief among which are that it is personal and non-assignable and enforceable only by the person whose privacy has been invaded.

The courts of New York have consistently held for over half a century that, save by appropriate action under the copyright, trade-mark or libel laws, there is no way a person can prevent the use of his name and likeness by others in this state except by invoking Sections 50 and 51 of the Civil Rights Law by which the Legislature created a limited right of privacy. The *name* by which this limited right is called is a matter of little moment, whether a right of privacy or a right of publicity; the important thing is that the right does not exist at common law in this state, but exists only by virtue of the statute. The extra-statutory, assignable right created by the Court of Appeals is utterly void.

This same question of law had previously been presented to the Court of Appeals for the Fifth Circuit, which held with the New York courts that the right of privacy is a personal, non-assignable right. The Court of Appeals for the Second Circuit expressly disagreed with the Fifth Circuit.

ARGUMENT.

The Right of Privacy

Around the turn of the century the likeness of one Abigail Roberson was reproduced, without her consent, upon lithographic prints on which also appeared the words "Flour of the Family" and "Franklin Mills Flour", and these prints were conspicuously posted and displayed in stores, warehouses, saloons and other public places, much to the lady's annoyance and distress. Miss Roberson sued for an injunction and damages in the sum of $15,000. Special Term and Appellate Division gave judgment for plaintiff, but the New York Court of Appeals, after a

thorough review of the authorities, held that the right asserted did not exist at common law and reversed the judgment below. *Roberson* v. *Rochester Folding Box Co.*, 171 N. Y. 538. The Court suggested however that

> "The legislative body could very well interfere and arbitrarily provide that no one should be permitted for his own selfish purpose to use the picture or the name of another for advertising purposes without his consent."

Whereupon, at its next session, the Legislature obliged by enacting the so-called New York right of privacy statute now embodied in the New York Code as Sections 50 and 51 of the Civil Rights Law. Section 50 makes unauthorized use of a living person's name, portrait or picture for purposes of advertising or trade a misdemeanor. Section 51 makes the same unauthorized use a statutory tort. This section reads, in part, as follows:

> "Any person whose name, portrait or picture is used within this state for advertising purposes or for the purposes of trade without the written consent first obtained as above provided may maintain an equitable action in the supreme court of this state against the person, firm or corporation so using his name, portrait or picture, to prevent and restrain the use thereof; and may also sue and recover damages for any injuries sustained by reason of such use. . . ."

One of the earliest cases to arise under the New York privacy law was *Wyatt* v. *Hall's Portrait Studio,* 128 N. Y. S. 247 (1911) (Supreme Court, New York County). Helen Wyatt had brought action against defendant Hall's Portrait Studio under Section 51 of the Civil Rights Law for an injunction and damages for the unauthorized use of her name and picture. During the pendency of the action Miss

Wyatt died and her administratrix brought a motion for an order permitting her to revive the action. Whether or not the action survived the death of the plaintiff, said Judge Seabury, depended upon whether it was an action *excontractu* or *ex delicto;* under the New York Code the former survives the death of the plaintiff and the latter does not. The question before the Court, therefore, was whether the violation of the right of privacy was a personal injury or not. In holding that it *was* a personal injury, the Court said:

> "The right of privacy, or, as it has sometimes been called, the 'right to be let alone', is in its nature personal. The peculiarly personal character of the cause of action created by the statute negatives the idea that the Legislature intended that it should be enforceable by the personal representatives of the person in whose favor the cause of action existed. The injury done by the violation of the right does not affect the estate of the person injured, but is strictly an injury to the person of the plaintiff. Nor does the fact that upon the violation of the right the person injured becomes entitled to damages alter the nature of the right or change the character of the cause of action which the statute sanctions" (p. 249).

The Court then went on to cite *Schuyler* v. *Curtis,* 147 N. Y. 434, which arose before the enactment of the right of privacy statute. But there the Court, assuming the existence of such a right, held that even so it died with the person and did not survive. Judge Peckham in the *Schuyler* case said: "Whatever right of privacy Mrs. Schuyler had died with her".

In the very recent case of *Gautier* v. *Pro-Football, et al.,* Supreme Court, Appellate Division, First Department, 106 N. Y. S. 2d 553 (affirmed 304 N. Y. 354, July 15, 1952),

Judge Shientag said:

> "The statutory creation in this state of a limited right of privacy was intended for the protection of the personality of an individual against unlawful invasion. See Roberson v. Rochester Folding Box Co., 171 N. Y. 538; Rhodes v. Sperry & Hutchinson Co., 193 N. Y. 223; affirmed 220 U. S. 502. * * * It provided primarily a recovery for injury to the person, not to his property or business. The recovery is grounded on the mental strain and distress, on the humiliation, on the disturbance of the peace of mind suffered by the individual affected. True, where an individual's right of privacy has been invaded there are certain other elements which may be taken into consideration in assessing the damages. Thus, where a cause of action under the Civil Rights statute has been established, damages may include recovery for a so-called 'property' interest inherent and inextricably interwoven in the individual's personality, see Redmond v. Columbia Pictures Corp., 277 N. Y. 707, 14 N. E. 2d 636, but it is the injury to the person not to the property which establishes the cause of action. That is the focal point of the statute.
>
> "* * * Section 51 of the Civil Rights Law was not enacted to fill gaps in our copyright statute * * *" (p. 560).

In practically all of the invasion of privacy cases, either of common law or statutory origin, the plaintiff has been the one whose privacy has been invaded—or who, at any rate, believes that it has been. There are, indeed, only two prior cases known to us in which a third party brought such a suit. The earlier and, perhaps, the more pertinent of these is *Pekas Co. Inc.* v. *Leslie, et al.*, 52 N. Y. L. J. 1864 (1915), Supreme Court, New York County. There certain motion picture actresses had given the plaintiff the exclusive right

to use their pictures or portraits on posterettes, art stamps, advertising stamps and seals. Subsequently, the actresses gave the defendant the right to use their portraits and the defendant did so, whereupon the plaintiff brought this action. In dismissing the complaint Justice Greenbaum said:

> "The complaint is clearly predicated upon the theory that the defendants are liable to plaintiff under sections 50 and 51 of the Civil Rights Law, entitled 'Rights of Privacy'. The history of the legislation resulting in that act is found in Rhodes v. Sperry & Hutchinson Co. (193 N. Y. 223), which convincingly established that it was prompted by the suggestions of the court in Roberson v. Rochester Folding Box Co. (171 N. Y. 538). A study of the learned prevailing opinion in the Roberson case (supra) clearly reveals that the 'Law of Privacy' is what the phrase indicates, not one designed to protect the rights of private property, but 'of an inviolate personality', based upon the regard of the law for the feelings and sentiments of the individual. The rights and remedies of the persons aggrieved are purely personal and not assignable. Rights for outraged feelings are no more assignable than would be a claim arising from a libelous utterance. The alleged agreements made between the actresses in question and the plaintiff, under which the plaintiff was given the exclusive right to publish the portraits, may have conferred rights which the plaintiff might have protected by copyright, but none in favor of the plaintiff against the defendants under the Civil Rights Law of Privacy. Judgment for the defendants without costs."

As the opinion was not reported in the New York Reports we have appended a copy of it, and also one of the contracts signed by an actress, which is strikingly similar to respondent's player contracts.

It is well settled that in New York the only redress a person can have for the unauthorized use of his name or picture for purposes of advertising or trade is the redress that Sections 50 and 51 of the Civil Rights Law afford him.

In *Rhodes* v. *Sperry & Hutchinson Co.*, 193 N. Y. 223, the New York Court of Appeals, construing the *Roberson* case, said:

> "In the case of Roberson v. Rochester Folding Box Co., 171 N. Y. 538, 59 L. R. A. 478, 89 Am. St. Rep. 828, 64 N. E. 442, this court determined that, in the absence of any statute on the subject, the right of privacy, as a legal doctrine enforceable in equity, did not exist in this state so as to enable a woman to prevent the use of her portrait by others for advertising purposes without her consent."

In *Kunz* v. *Bosselman*, 115 N. Y. S. 650, Supreme Court, Appellate Division, Second Department, the Court said:

> "At common law an action would not lie to restrain the publication of one's portrait, where it was not alleged that the publication was libelous. Roberson v. Rochester Folding Box Co., * * *. Such publication may now, however, be restrained in this state, under chapter 132, p. 308, of the Laws of 1903"—(now sections 50 and 51 of Civil Rights Law).

In *Wilson* v. *Brown*, 73 N. Y. S. 2d 587, 589, Supreme Court, Special Term, Kings County the Court said:

> "At common law there does not seem to have been any protection that an individual could claim against a legal, nonlibelous, nonfraudulent mention of his name; our statute should be strictly construed." (Citing Roberson v. Rochester Folding Box Co.)

In *Sidis* v. *F-R Pub. Corporation*, 113 F. 2d 806, 810, the Court of Appeals for the Second Circuit correctly interpreted the New York statute:

> "Before passage of this statute (Sections 50, and 51 of the New York Civil Rights Law) it had been held that no common law right of privacy existed in New York. Roberson v. Rochester Folding Box Co., 171 N. Y. 538, 64 N. E. 442, 59 L. R. A. 478, 89 Am. St. Rep. 828. Any liability imposed upon defendant must therefore be derived solely from the statute, and not from general considerations as to the right of the individual to prevent publication of the intimate details of his private life."

It is significant that not once since 1903 when the Legislature passed what are now sections 50 and 51 of the Civil Rights Law, has any person sued in the courts of New York for redress for the unauthorized use of his name or portrait for purposes of advertising or trade and been given relief under the common law. Whatever extra-statutory rights famous—or even infamous—persons may have had in their names and portraits, none has enforced them in New York in the past fifty years. Even when the complaint has not specifically pleaded the statute the courts have assumed the action to be one for statutory relief and acted accordingly. In the *Pekas* case the statute was not pleaded, but Justice Greenbaum wrote: "No question of copyright is involved. The complaint is clearly predicated upon the theory that the defendants are liable to plaintiff under sections 50 and 51 of the Civil Rights Law, entitled: 'Rights of Privacy'."

If there is such a thing at common law as a "right of publicity", a right "in addition to and independent of" the right of privacy, is it not strange that no one has ever asserted that right in the courts of New York? Or so much as mentioned it?

The "Right of Publicity"

What then is this new thing, this "right of publicity" created by the Court of Appeals? At first blush it would seem to be the reverse of the right of privacy. If the right of privacy is the negative right *not* to have one's name or likeness used for purposes of advertising or trade, then the right of publicity must be the affirmative right *to* have one's name or likeness so employed. But when thus stated is it not at once apparent that this right is guaranteed to each of us, not only by the Constitution of the State of New York, but by the Federal Constitution as well? To cite authority would be supererogatory. Any man, woman or child in these United States who yearns for publicity can have his name and picture published in the daily press or distributed on handbills, or used for purposes of trade, provided only that he or she has the price of the space or the printing or access to the trade. Surely petitioner has stood in no ball player's way. On the contrary.

So the "right of publicity" must be something more than the affirmative right to use one's name or picture publicly. Is it not then the right to *exclude others* from so using one's name or picture? Yes, on the authority of Judge Frank himself. So are we not saying that each of us has the right *not* to have his name or picture publicly used? There is no such unqualified right, of course, or newspapers would have to suspend publication. But the right not to have one's name or picture used for purposes of advertising or trade *is* a *statutory* right in New York State —the right of privacy! So the wheel has come full circle and Judge Frank's newly created "right of publicity" turns out to be our old friend, the right of privacy, in a different verbal dress. But if so, then it must be subject to the limitations that the New York courts have placed upon it. It may not be assigned. It may not be bequeathed. It must be enforced by the living person whose exclusive right of publicity has been infringed, and not by his assignee, grantee or legatee.

This hybrid creature of the Court of Appeals, this impersonal, assignable, bequeathable "right of publicity" was never seen on sea or land before it sprang from the Jovian judicial brow. But not, we must add, full-panoplied like Minerva, or implemented like our copyright laws. One serious practical difficulty that presents itself is this: the assignee of this new right has nowhere to record his title. There is no duly organized Publicityright Office, either in Albany or Washington, where a man can go to find out whether or not Roy Campanella or Bob Feller has assigned his "right of publicity" in the realm of bubble gum to respondent, and whether petitioner may safely negotiate with Roy or Bob for the purchase of that right to exercise in connection with petitioner's gum.

Mr. Red Smith, writing his column in the New York Herald Tribune on March 27, 1953 under the title "The Battle of Bubble Gum" pointed out some of the difficulties involved in enforcing this new "right of publicity". After quoting Judge Frank's enunciation of the right, Mr. Smith, an expert on baseball players as well as publicity, wrote:

> "This is an interesting view and one could wish that Judge Frank had expanded it, studying its application to some typical cases. For example, there is the baseball reporter who writes, say, a hundred pieces of unstinting praise of a first baseman. There comes a day when duty compels him to report, as Boston's John Gilooly did on one occasion, that the first baseman approached a ground ball 'as though it were a hooded cobra'.
>
> "The player, who has never previously betrayed his ability to read, now gives off piercing animal cries and offers to stuff the published article down the reporter's guzzle. 'You are taking the bread and butter out of my mouth!' he wails.
>
> "Which principle applies here? Does the right of publicity govern in the first 100 cases and the right of privacy only in the 101st? * * *

> "Virtually all athletes would subscribe cheerfully to a rule invoking the right of publicity when the publicity is favorable and the right of privacy in all other instances."

But this may be beside the point. The point is that if the "right of publicity" is something "in addition to and independent of" the right of privacy and assignable in gross, as the Court of Appeals has declared, then its creation was an act of judicial legislation which cannot be tolerated. If, on the other hand, the "right of publicity" is only the right of privacy otherwise expressed, then those who would enforce it in New York are bound by the limitations the courts of this state have placed upon it.

After finding that the right involved was the "right of publicity" the Court of Appeals added: "We think the New York decisions recognize such a right" citing two New York cases and one old federal case. The doubt implicit in "We think" is well justified by the authorities cited, none of which is in point.

Wood v. *Duff-Gordon,* 222 N. Y. 88. The defendant, Lady Duff-Gordon a "creater of fashions", had given plaintiff the exclusive right for one year to place her endorsements on the designs of others and to place her own designs on sale. In return she was to have one-half of all profits and revenues derived from any contracts the plaintiff might make. But the defendant placed her endorsement on fabrics, dresses and millinery without plaintiff's knowledge and withheld the profits and revenues received, for which she was sued. The case turned on whether or not there was an enforceable contract. The Court of Appeals held that there was. No "right of publicity" was involved, and in any event, the only person whose publicity might have been involved was Lady Duff-Gordon and she was the defendant. This case has no bearing on the case at bar. It is as though respondent should sue a ball player for breach of contract.

Madison Square Garden Corp. v. *Universal Pictures Co. Inc., et al.*, 7 N. Y. S. 2d 845. The defendant, Universal Pictures Co., produced and distributed a motion picture, "Idol of the Crowds", purporting to show professional ice hockey games in New York City, including pictures of a professional ice hockey game, "The Rangers" controlled by the plaintiff. The defendant intended that the persons seeing the picture should believe they were viewing professional ice hockey games played in Madison Square Garden and scenes therein, and that plaintiff had approved the inclusion of such scenes when such was not the case. The Court held that this was unfair competition, saying: "Defendants infringed on plaintiff's property rights as well as violated the implied obligations flowing from their contract with the plaintiff". It is difficult to see in this situation any analogy to the instant case or any recognition of an individual's "right of publicity".

Liebig's Extract of Meat Co. v. *Liebig Extract Co.*, 180 Fed. 688, 2 Cir. This is a trade-mark case in which the Court held that defendant was infringing plaintiff's trade-mark LIEBIG. We do not deny that a surname may acquire a secondary meaning and serve as a valid trade-mark. But the names of none of the ball players involved in this litigation were used as trade-marks or had acquired a trade-mark status. Why the Court of Appeals should have cited this old case is a mystery.

THE DECISION OF THE SUPREME COURT OF NEW YORK IN THE PEKAS CASE

As we have pointed out, this case, decided by the Supreme Court of New York, is on all fours with the instant case. It has been cited by Prosser in his Handbook of the Law of Torts, Hornbook Series, 1941, page 1059, and by Callmann in his "Unfair Competition and Trade-Marks" 2d Ed. 1950, Vol. 1, page 48, both to the proposition that

the right of privacy is personal and incapable of assignment. Nevertheless the Court of Appeals does not think it controlling; for one reason because it entertains "a doubt as to whether an opinion of that court must be taken by us as an authoritative exposition of New York law". Why not? As this Court held in *Fidelity Trust Co.* v. *Field,* 311 U. S. 169, 177:

> "The highest state court is the final authority on state law (*Beals* v. *Hale,* 4 How. 37, 54; *Erie Railroad Co.* v. *Tompkins,* 304 U. S. 64, 78), but it is still the duty of the federal courts, where the state law supplies the rule of decision, to ascertain and apply that law even though it has not been expounded by the highest court of the State. See *Ruhlin* v. *New York Life Insurance Co.,* 304 U. S. 202, 209. An intermediate state court in declaring and applying the state law is acting as an organ of the State and its determination, in the absence of more convincing evidence of what the state law is, should be followed by a federal court in deciding a state question" (pp. 177, 178).

The reason is clear, as this Court pointed out further on in the *Fidelity* case:

> "The question has practical aspects of great importance in the proper administration of justice in the federal courts. It is inadmissible that there should be one rule of state law for litigants in the state courts and another rule for litigants who bring the same question before the federal courts owing to the circumstance of diversity of citizenship" (pp. 179, 180).

That is precisely the situation here. Defendant, a New York corporation, is entitled to be judged by the laws of its own state. There is, besides, a very particular reason why a decision of the Supreme Court of New York should be controlling here. By Section 51 of the Civil Rights Law

the Legislature has specifically provided that a person aggrieved "may maintain an equitable action in the supreme court of this state".

The other reason why the Court of Appeals thought the *Pekas* case not controlling was this:

> "* * * the opinion shows that the judge had his attention directed by plaintiff exclusively to Sections 50 and 51 of the New York statute, and accordingly, held that the right of privacy was 'purely personal and not assignable' because 'rights for outraged feelings are no more assignable than would be a crime arising from a libelous utterance' " (R. 761).

But what Justice Greenbaum's opinion shows is something quite different: that unless the action *were* "predicated upon the theory that the defendants are liable to plaintiff under Sections 50 and 51 of the Civil Rights Law", there would be no cause of action at all. As a matter of fact the plaintiff in the *Pekas* case did not plead the statute, but its invocation was plain to the Court, nevertheless.

Although the courts of New York have been fond of referring to the "outraged feelings" of plaintiffs suing under Section 51, there is no mention of sensibilities in the statute itself. The right conferred, although limited, is absolute within its limits. The most callous publicity seeker whose name or picture has been used for purposes of advertising or trade without his consent is in the same position before the law as the most sensitive recluse. *Gautier* v. *Pro-Football,* 304 N. Y. 354.

This newly created "right of publicity" is, by postulate, the property of "prominent persons" who hanker for "public exposure of their likenesses". The distinction between prominent and obscure persons was considered and rejected in the *Roberson* case. A Michigan court had dis-

tinguished between a private individual and a public character. In rejecting this invidious distinction the New York Court of Appeals said:

> "This distinction between public and private characters cannot possibly be drawn. On what principle does an author or artist forfeit his right of privacy, and a great orator, a great preacher, or a great advocate retain his? Who can draw a line of demarcation between public characters and private characters, let that line be as wavering and irregular as you please?"

The U. S. Court of Appeals was moved to create this "right of publicity" apparently because it felt that the right of privacy would not adequately compensate "prominent persons" who "would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses, trains and subways. This right of publicity would usually yield them no money unless it could be made the subject of an exclusive grant which barred any other advertisers from using their pictures." Sweet are the uses of publicity. Sweet indeed, but they may be savored under the existing law. There is no reason why an actor or a shortstop, a crooner or an outfielder, may not give an exclusive waiver of his right of privacy in any given field, charging whatever price he can command, and sue anyone else who uses his name or picture in that field. What the courts of New York have held is that this waiver of an individual's right of privacy may not be assigned and enforced by the assignee.

The Decision of the Court of Appeals for the Fifth Circuit in the Hanna Case.

Hanna Mfg. Co. v. *Hillerich & Bradsby Co.*, 78 F. 2d 763, 5 Cir. (1935), is the other case involving the right of privacy in which the persons whose privacy was involved

were not parties. Certain baseball players had given to the plaintiff, Hillerich & Bradsby Co., manufacturers of the famous LOUISVILLE SLUGGER BAT, the exclusive right to use their names, autographs and photographs in connection with the advertising and sale of baseball bats, and had consented to the registration of their names as trademarks. It seems that different famous batters, like Babe Ruth or Lou Gehrig used special bats which were known in the trade as RUTH BATS or GEHRIG BATS, as the case might be. The defendant, Hanna Mfg. Co., was selling such bats as RUTH or GEHRIG BATS, and when sued took the position that each of those names was used truthfully to identify a particular style bat. Hillerich & Bradsby Co. insisted, however, that the baseball players, like other individuals, have a property right to their names and that this property right is capable of assignment and had been assigned to the plaintiff. The District Court had accepted this argument, but the Court of Appeals, speaking through Judge Sibley, disagreed, and after a brief review of the cases involving violation of the right of privacy, said:

> "* * * From this incomplete review it is evident that a famous batsman, aside from questions of trademark and unfair competition or libel, might have difficulty in keeping his name and likeness from respectful use by others. But if they be his property in a sense, they are not vendible in gross so as to pass from purchaser to purchaser, unconnected with any trade or business. Fame is not merchandise. It would help neither sportsmanship nor business to uphold the sale of a famous name to the highest bidder as property. Moreover, appellee is not by its contracts the assignee as of property of the name and likeness of these players. The usual form of the contract grants 'the sole and exclusive right for twenty years of the use of my name, autograph, portrait, photograph, initials or nickname for trade-mark or advertising purposes in connection with the manufacture or sale of baseball bats'. The

> signer does not divest himself of his name and likeness, but gives a permission or license to use them for a stated purpose and for a limited time. Since the players were not makers or sellers of bats and sold no business together with its marks and good will to appellee, *the contracts in our opinion in and of themselves operate only to prevent the signers from objecting to appellee's use of their names and likenesses.* The right or wrong as against appellee of their use by others rests on the law of trade-mark and unfair competition, or unfair trade, and depends not so much on appellee's contracts as on the actual use in trade by appellee of the names and likenesses. It is the trade rather than the names and likenesses which the law will protect as property." (Italics ours.) (pp. 766-767)

The Court permitted the defendant to continue its sale of its Ruth and Gehrig style bats but required it "to add to the player's name 'style' or 'shape'."

In expressly refusing to follow the decision in the *Hanna* case the Court of Appeals for the Second Circuit added an explanatory footnote (R. 761):

> "It should be noted that the *Hanna* case was a *pre-Erie-Tompkins* decision, which, although it discussed the New York decisions, did not purport to decide authoritatively the New York 'law' on the subject."

In 1935 when the *Hanna* case was decided it was, so far as the Court of Appeals for the Fifth Circuit knew, a case of first impression. In no other known case had a third party sued for violation of another's right of privacy. The *Pekas* case had, of course, been decided but having been reported only in the New York Law Journal, was doubtless unknown in the Fifth Circuit. The Court of Appeals for the Fifth Circuit was, therefore, casting about for such guidance as it could find and naturally turned to the New

York cases. Although it is true that the Court "did not purport to decide authoritatively the New York law on the subject", it did, nevertheless, render a decision consonant with New York law.

CONCLUSION.

Fifty years ago the *New York* Court of Appeals, finding the common law inadequate to redress a woman whose picture had been used in advertisements without her consent, suggested that the Legislature might wish to enact a statute providing "that no one should be permitted for his own selfish purpose to use the picture or name of another for advertising purposes without his consent." The Legislature promptly accepted the suggestion and passed the right of privacy statute. If now the *United States* Court of Appeals finds that statute inadequate to compensate "prominent persons" for the use of "their countenances displayed in newspapers, magazines, busses, trains and subways", another suggestion addressed to the Legislature may be in order. But until the Legislature has acted on that suggestion and established a new form of statutory copyright in this state to be known as a "right of publicity," assignable in gross, the United States Court of Appeals should make do with the existing law as the New York courts have construed it; otherwise endless confusion will ensue.

Judge Galston correctly summed up the existing law in his scholarly opinion (R. 722, 723):

> "Thus it may be said that before the enactment of Sections 50 and 51 of the Civil Rights Law, there was in New York no legal basis for protection against the unauthorized use of a person's name or portrait (in the absence of a violation of the law dealing with libel and slander, or some independent property or contract right). With the enactment of Sections 50

and 51, the legislature granted certain limited protection against unauthorized publication of a person's name or picture; that is, where the intended use is 'for advertising purposes or for the purpose of trade.' The protection thus granted by statute is a right of privacy, construed by the courts of the state as being a purely personal right and non-assignable.

* * * * * * * * * * *

"I conclude that the plaintiff has failed to sustain the cause of action alleged."

THE JUDGMENT OF THE DISTRICT COURT SHOULD BE AFFIRMED AND THAT OF THE COURT OF APPEALS REVERSED, AND TO THAT END WE URGE THE COURT TO GRANT THIS PETITION.

Respectfully,

GEORGE E. MIDDLETON,
Counsel for Petitioner,
247 Park Avenue,
New York 17, N. Y.

New York, N. Y.,
May 21, 1953.

APPENDIX.

Opinion of Justice Greenbaum in *Pekas Co. Inc.* v. *Leslie, et al.*, 52 N. Y. L. J. 1864, February 13, 1915 (and Complaint Exhibit A).

PEKAS* CO., INC. v. LESLIE, *et al*

52 N. Y. L. J. 1864, February 13, 1915,

Supreme Court, Special Term, New York County.

GREENBAUM, Justice:

The parties have stipulated all the facts, which may be briefly summarized. The plaintiff, a publisher of posterettes, art stamps and advertising stamps, secured from certain named motion pictures actresses the exclusive right to use their pictures or portraits on posterettes, art stamps, advertising stamps and seals for a period of five years, variously commencing in June and July, 1914, and thereafter published posterettes and stamps containing the portraits of such actresses. The defendant thereafter also published and sold posterettes or portrait stamps of the same actresses, without the permission, written or otherwise, of the plaintiff. It, however, appears from each of the several affidavits of the actresses in question, and which, pursuant to the stipulation between the parties, may be considered by the court upon this submission, that the portraits published by the defendant had been given to the defendant with authority "to print, reproduce and publish in any manner which would place my said portrait before the public, provided

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* The correct spelling of this name is PAKAS. However, this small typographical error, made originally by the Law Journal, has been repeated wherever the case has been cited, so that it is simpler to perpetuate the error than try to correct it at this late date.

G. E. M.

it was not used to advertise an article of merchandise," and that plaintiff has not been authorized by any of said actresses "to bring any action for injunctions or, damages against said defendants, or either of them; that I have received no money or other consideration from the plaintiff for the reproduction of said portraits," and "I ask that no injunction be issued in this action." No question of copyright is involved. The complaint is clearly predicated upon the theory that the defendants are liable to plaintiff under sections 50 and 51 of the Civil Rights Law, entitled "Rights of Privacy." The history of the legislation resulting in that act is found in Rhodes v. Sperry & Hutchinson Co. (193 N. Y., 223), which convincingly establish that it was prompted by the suggestions of the court in Roberson v. Rochester Folding Box Co. (171 N. Y., 538). A study of the learned prevailing opinion in the Roberson case (supra) clearly reveals that the "Law of Privacy" is what the phrase indicates, not one designed to protect the rights of private property, but "of an inviolate personality," based upon the regard of the law for the feelings and sentiments of the individual. The rights and remedies of the persons aggrieved are purely personal and not assignable. Rights for outraged feelings are no more assignable than would be a claim arising from a libelous utterance. The alleged agreements made between the actresses in question and the plaintiff, under which the plaintiff was given the exclusive right to publish the portraits, may have conferred rights which the plaintiff might have protected by copyright, but none in favor of the plaintiff against the defendants under the Civil Rights Law of Privacy. Judgment for the defendants, without costs.

PEKAS v. LESLIE
Complaint Exhibit A

June 15, 1914

The Pakas Company, Inc.,
833 Whitehall Bldg.,
New York City, N. Y.

Gentlemen:

In consideration of your company publishing my photographs at no cost to me, as a part of the Photo-play Star Series of POSTERETTES, I herewith grant to you the sole and exclusive right to use my photographs for reproduction on POSTERETTES (art stamps, advertising stamps, and seals), for a period of five years from date. This grant is made with the understanding that the series of POSTERETTES on which my pictures appear will be circulated throughout the world as occasion requires.

I agree to furnish your company with one photograph each of as many poses as you may require in the publication of the POSTERETTES.

Very truly yours,

s/ EDITH STOREY